

## Remarks

In Paragraphs 1 and 2 of the pending Office Action, the Examiner set forth an election/restriction requirement. The Office Action restricts pending claims 1-13 as follows:

Group I: is drawn to a an amino acid composition, classified in class 514, subclass 19, currently embodied in claims 1-7 and 13.

Group II; is drawn to a method of in vivo use of an amino acid composition classified in class 51, subclass 14, currently embodied in claims 8-12.

### **I. Restriction.**

Applicants provisionally elect, with traverse, Group I. According to Section 803 of the M.P.E.P., restriction may properly be required between patentably distinct inventions if (1) the inventions are independent or distinct as claimed; and (2) there is a serious burden on the Examiner if restriction is not required. In this case, the entire patent system would be unnecessarily burdened with the additional application required and the duplicative work this restriction demand entails.

Specifically, Applicants respectfully submit that there will not be a serious burden on the Examiner if restriction between the claims is not required because regardless of the claims prosecuted, the field of search for each of the identified species will substantially overlap, if not be identical to the other. A separate field of search is shown to exist only when one of the distinct subjects can be searched in places where no pertinent art to the other subject exists. In this case, however, there is no indication that a separate field of search is required for the disclosed inventions. Thus, Applicants respectfully contend that there will not be a serious burden on the Examiner if restriction is not required and would respectfully request that this restriction requirement be withdrawn.

### **II. Election of Species.**

In paragraph 1, the Examiner further states that pending claims 1-7 are generic to a plurality of disclosed patentably distinct compounds comprising a combination of three prodrug

compounds wherein: (i) the first compound, A, can be any one of 20 amino acids; (ii) the second compound, B, can be a bond between A and C or any one of 20 amino acids or proline, hydroxyproline, thiazolidinecarboxylic acid, dehydroproline, pipecolic acid, azetidinecarboxylic acid or aziridinecarboxylic acid; and, (iii) the third compound, C, is a stable inhibitor of DP IV that can be any one of aminoacylpyrolidide, aminoacylthiazolidide or N-dipeptidyl, O-acyl hydroxylamine. The Examiner is requesting that the Applicants elect a single species of the disclosed components ABC. The Applicants respectfully traverse this election of species requirement, however, provisionally elect the following single disclosed prodrug compound, this elected prodrug is as follows: Pro-Ile-Thia.

Specifically, Applicants respectfully submit that there will not be a serious burden on the Examiner if election of species is not required because regardless of the claims prosecuted, the field of search for each of the identified species will substantially overlap, if not be identical to the other. A separate field of search is shown to exist only when one of the distinct subjects can be searched in places where no pertinent art to the other subject exists. In this case, however, there is no indication that a separate field of search is required for each of the disclosed species. Thus, Applicants respectfully contend that there will not be a serious burden on the Examiner if restriction is not required and would therefore respectfully request that the species election be withdrawn.

### CONCLUSION

The claims remaining within the application are believed to patentably distinguish over the prior art and to be in condition for allowance. Early and favorable consideration of this application is respectfully requested.

Respectfully submitted,

---

John C. Serio  
Attorney for Applicants  
Reg. No. 39,023  
Customer No. 21710  
Brown Rudnick Berlack Israels LLP  
One Financial Center  
Boston, MA 02111  
Tel: (617) 856-8238  
Fax: 617-856-8201

Dated: November 19, 2002 .

#1146144 - 20784/4